

REMARKS

This is in full and timely response to the above-identified Office Action. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested.

The Drawings

In this response, the specification has been amended to eliminate the use of "Figure 1" on page 7, and claim 10 has been amended to remove the reference to an "arc tube". These corrections overcome the objections raised in connection with the drawings under 37 CFR §§ 1.83(a) and 1.84(u).

Claim Objections

The claims have been revised to obviate the objection raised in connection with claims 4, 8 and 15. The antecedent problem in claims 2 and 3 has also been overcome by the amendments which have been made in this response. The rejection under 35 USC § 112, second paragraph is therefore deemed overcome.

Rejections under 35 USC § 102

The rejection of claims 1-9 and 11-16 under 35 US § 102(b) as being anticipated by Kaduk et al., are respectfully traversed.

Kaduk et al. teach the provision of four layers 9, 10, 11 and 12. Layer 9 is a thin clear layer formed of TiO_2 . Layer 10 is a reflective layer which is formed of particulate TiO_2 . Layer 11 is an undercoat which can comprise a mixture of $\text{MgO}/\text{Al}_2\text{O}_3$, and layer 12 is a phosphor coating.

The claims distinguish over this by calling for the reflective layer to be a reflective layer which is between an inner surface of the lamp envelope and the layer of

luminescent material, for reflecting ultraviolet radiation, which has passed through the layer of luminescent material back into the luminescent material for increasing the visible light output of the luminescent material. This reflective layer is also required to consist essentially of a particulate non-fluorescent oxidic material and a getter material which reacts with contaminants present in the lamp. Therefore the claimed reflective layer cannot be read on the TiO_2 layer disclosed in Kaduk et al.

It is fully appreciated that Kaduk et al. disclose a layer formed of $\text{MgO}/\text{Al}_2\text{O}_3$. However, this layer is not disclosed as being a reflective layer. In fact, it is the second layer of particulate TiO_2 which is clearly disclosed as being the reflective layer in the multilayer arrangement disclosed in Kaduk et al. It is submitted that Kaduk et al. therefore do not have a reflective layer which is formed of $\text{MgO}/\text{Al}_2\text{O}_3$ and therefore cannot meet the claimed requirements of a reflective layer made of such a material.

It is also submitted that the hypothetical person of ordinary skill would not be lead to the understanding that the $\text{MgO}/\text{Al}_2\text{O}_3$ layer could be used as a reflective layer. Kaduk et al. clearly disclose the use of a different material which has this property and then disposes the $\text{MgO}/\text{Al}_2\text{O}_3$ over the top of the TiO_2 layer with no disclosure or suggestion that this $\text{MgO}/\text{Al}_2\text{O}_3$ layer has any reflective properties and could be used in the manner set forth in the claims. This claimed arrangement is therefore deemed also non-obvious in light of the teachings which can be gleaned from this reference.

New Claims

New claims 17 – 20 have been presented for examination. These method claims find full support in the specification – see page 9, lines 8-22, for example. It is submitted that these claims define subject matter which is patentable over the art of record in that they define a process which is neither disclosed nor suggested therein.

It is respectfully submitted that these claims should be examined and allowed along with the originally presented claims 1-16. More specifically, a notice was published in the *Official Gazette* on March 26, 1996 which established guidelines for treatment of product and process claims in light of *In re Ochiai* and *In re Brouwer*.

As a result of the rejoinder procedure provided for in this Notice and in order to expedite prosecution, applicants are in fact encouraged to present such process claims in the application at an early stage of prosecution. Process claims which depend from or otherwise include all the limitations of a patentable product claim will be entered as a matter of right if the amendment is presented prior to final rejection.

It is respectfully submitted that this negates any contemplation that the claims should be withdrawn on a basis of original presentation.

Conclusion

It is respectfully submitted that the newly presented claims are allowable along with those amended in this response. Favorable reconsideration and allowance of this application is courteously solicited.

Respectfully submitted,

By 

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